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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,424	01/30/2002	Arda Aksu	782.1116	4299

21171 7590 10/13/2006

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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,424

Applicant(s)

AKSU ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 and 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-19 and 23-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. This non-final Office action is responsive to Applicant's election filed July 31, 2006.

Applicant has elected Species I with traverse.

Non-elected claims 6-9 and 20-22 stand as withdrawn.

Claims 1-5, 10-19, and 23-32 are presented for examination.

Response to Arguments

2. Applicant's arguments filed July 31, 2006 have been fully considered but they are not persuasive.

Applicant traverses the restriction requirement for the following reasons:

The Applicants respectfully submit that the election of species requirement is not well founded. A review of the application reveals that the various embodiments are so closely related as to not require separate fields of search. Accordingly, neither the Applicants nor the U.S. Patent and Trademark Office should be put through the trouble and expense entailed in multiple filing and prosecution...

The Applicants note that the making of an election of species requirement is not mandatory in all instances where it is possible to do so... (Pages 1-2 of Applicant's response)

The Applicant fails to submit any evidence as to why the restriction requirement is allegedly improper. The financial burden incurred by processing various applications is not a legitimate challenge to a restriction requirement. Additionally, the fact that the Examiner has discretion in making a restriction requirement does not support Applicant's assertion that the restriction requirement is improper. The Examiner has

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used her discretion to make the restriction requirement in the instant application. It should also be noted that, regardless of where each species would be classified, Applicant's own specification describes each species as a mutually exclusive and separately patentable embodiment. Applicant has not challenged this assertion, e.g., by explaining that the species are obvious variants of one another. Due to Applicant's failure to present a persuasive traversal of the restriction requirement, this requirement is maintained.

Claim Objections

3. Claim 30 is objected to because of the following informalities:

Claim 30, line 2, delete "math", insert -- match --

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 23 recites a "computer-readable storage controlling a computer and comprising a process of..." In order to properly recite a computer program product (i.e., an article of manufacture) claim, the computer-readable medium must store thereon

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computer-executable instructions. It is not clear what is meant by the "computer-readable storage...comprising a process." Instead, the computer-readable storage should comprise instructions that, when executed, cause the computer to perform the recited process steps.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 10-19, 23, 25, 27, and 29-32 are rejected under 35 U.S.C. 102(a, e) as being anticipated by Lauffer (U.S. Patent No. 6,223,165).

Lauffer discloses a system for real-time connection of a customer and an expert, comprising:

[Claim 1] a database storing information about registered customers and experts, the information comprising keywords (col. 5, lines 35-65; col. 9, lines 19-21, 32-36 -- In order to perform the matching as described by Lauffer, the keywords must be stored in

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a database, even if the database is just temporary storage) provided by the experts during registration (col. 9, lines 25-30); and

a server, during a communication session, receiving a question from one of the customers, sending the question to experts determined by matching keywords in the question with the keywords in the database, and establishing a connection between the customer and an expert selected by the customer from experts wanting to answer the question (col. 5, lines 35-65; col. 9, lines 5-21, 25-36);

[Claim 10] a prepaid server charging accounts of the customer and the selected expert after the connection is disconnected and a conversation between the customer and the selected expert ends (col. 8, lines 25-29, 42-48 -- Cyber money accounts imply prepaid accounts, especially since reference is made to "proper deductions and credits"; col. 9, lines 49-55);

[Claim 11] wherein the information stored about customers comprises name, account number, a phone number of a short messaging service-enabled mobile phone, address, and a preferred language (While Lauffer teaches that entries in a customer's individual entries (such as identity, i.e., name) can be withheld from the experts, as seen in col. 6, lines 17-23, Lauffer does not expressly teach the specific data recited in claim 11, including account number, a phone number of a short messaging service-enabled mobile phone, address, and a preferred language. These differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements; therefore, such differences do not effectively serve to patentably distinguish the claimed invention over the prior art.

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For example, this data is never utilized in any specific calculations or other type of analysis requiring this particular type of data. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106);

[Claim 12] wherein the information stored about experts further comprises name, account number, a phone number of a short messaging service-enabled mobile phone, address, languages spoken, expertise area, and charge rate (While Lauffer teaches that entries in an expert's individual entries (such as identity, i.e., name, and address) can be withheld from the customers, as seen in col. 6, lines 17-23 and col. 9, lines 19-21, Lauffer does not expressly teach the specific data recited in claim 12, including account number, a phone number of a short messaging service-enabled mobile phone, languages spoken, expertise area, and charge rate. These differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements; therefore, such differences do not effectively serve to patentably distinguish the claimed invention over the prior art. For example, this data is never utilized in any specific calculations or other type of analysis requiring this particular type of data. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not

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distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106);

[Claim 13] wherein the information stored about the experts further comprises ratings of experts (col. 5, lines 55-56, 59-65);

[Claim 14] wherein the keywords in question are determined by the server performing text indexing on the question, and the keywords in the question are used by the server to query the database to perform keyword matching between the keywords in the question and the keywords provided by the experts during registration (col. 5, lines 35-65 -- Well-known keyword matching techniques, such as those used by Yahoo! and eBay, are utilized; col. 9, lines 25-27);

[Claim 15] wherein the experts wanting to answer the question are provided to the customer based on the percentage of the keywords matched (col. 5, lines 35-65; col. 9, lines 39-41 -- A relevance score of 1.0 is optimal, i.e., a 100% match has been identified);

[Claim 16] wherein the server removes information from the question sent to the experts that would identify the customer (col. 6, lines 17-23).

Lauffer discloses an advisory method, comprising:

[Claim 17] receiving a question from a registered customer during a communication session (col. 5, lines 35-65; col. 9, lines 25-36);

sending the question to a plurality of registered experts during the communication session, the experts receiving the question determined by matching keywords in the question with keywords provided by the experts during registration (col. 5, lines 35-65; col. 9, lines 25-36); and

establishing a connection during the communication session between the customer and an expert selected by the customer from experts wanting to answer the question (col. 5, lines 35-65; col. 9, lines 25-36);

[Claim 18] charging accounts of the customer and the selected expert after the connection is disconnected and a conversation between the customer and the selected expert ends (col. 8, lines 25-29, 42-48 -- Cyber money accounts imply prepaid accounts, especially since reference is made to "proper deductions and credits"; col. 9, lines 49-55);

[Claim 19] performing text indexing on the question to determine the keywords in the question, and using, by the server, the keywords in the question to query the database to perform keyword matching between the keywords in the question and the keywords provided by the experts during registration (col. 5, lines 35-65 -- Well-known keyword matching techniques, such as those used by Yahoo! and eBay, are utilized; col. 9, lines 25-27).

[Claim 23] Claim 23 recites limitations already addressed by the rejection of claim 17 above; therefore, the same rejection applies.

Lauffer discloses a method, comprising:

[Claim 25] selecting an expert based on a question submitted by a customer (col. 5, lines 35-65; col. 9, lines 5-14, 25-36); and

connecting, directly, the expert and the customer via a telephone call (col. 5, lines 35-65; col. 9, lines 5-14, 25-36);

[Claim 27] wherein the question is submitted to the expert without identifying the customer (col. 6, lines 17-24);

[Claim 29] wherein the connecting comprises a telephone call to the expert bridged to a telephone call to the customer (col. 9, lines 15-21);

[Claim 30] wherein the selecting comprises:

determining a word index match between the question and keywords describing expertise of more than one expert (col. 5, lines 35-65; col. 9, lines 39-41 -- A relevance score of 1.0 is optimal, i.e., a 100% match has been identified); and

designating the expert with a highest percentage match (col. 5, lines 35-65; col. 9, lines 39-41 -- A relevance score of 1.0 is optimal, i.e., a 100% match has been identified);

[Claim 31] wherein the selecting comprises:

determining a word index match between the question and keywords describing expertise of several experts (col. 5, lines 35-65; col. 9, lines 39-41 -- A relevance score of 1.0 is optimal, i.e., a 100% match has been identified); and

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providing the customer with a list of the experts with a highest percentage match (col. 5, lines 35-65; col. 9, lines 39-41 -- A relevance score of 1.0 is optimal, i.e., a 100% match has been identified);

[Claim 32] wherein the selecting and connecting are within a single communication session (col. 9, lines 5-55).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-5, 24, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lauffer (U.S. Patent No. 6,223,165), as applied to claims 1, 25, and 27 above.

[Claims 2-5] Lauffer discloses that communications between customers and experts "can include any method of technology used to bring together the consumer with one or more experts, including but not limited to telephone, Internet telephony, email, audio, and/or video. More preferably, the connection involves telephone, Internet telephony, audio, and/or video, and even more preferably Internet telephony, audio and/or video, and even more preferably video. The technology to be used for any of the above includes TVs, TVs with set-top web browsers, PCs, telephones, and satellite connections." (Col. 9, lines 5-14) Lauffer does not expressly teach that the customers

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and experts communicate with the server using short messaging service messages (claim 2), wireless phones (claim 3), Voice over Internet Protocol (VoIP) (claim 4), or IP multicasting (claim 5). However, Official Notice is taken that each of these modes of communication was individually old and well-known in the art at the time of Applicant's invention. Different people have preferences for different types of communication media; therefore, an increased availability of multiple communication media would also increase the number of people with whom communications may be established.

Consequently, since Lauffer specifically states that communications between customers and experts "can include any method of technology used to bring together the consumer with one or more experts, including but not limited to...", the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Lauffer to allow the customers and experts to communicate with the server using short messaging service messages (claim 2), wireless phones (claim 3), Voice over Internet Protocol (VoIP) (claim 4), or IP multicasting (claim 5) in order to accommodate a greater number of communication media, thereby attracting a wider body of potential customers and experts (which in turn would potentially generate greater profit opportunities for the implementation of Lauffer's invention).

Lauffer discloses an advisory method, comprising:

[Claim 24] registering a plurality of customers and a plurality of experts, the experts providing keywords (col. 5, lines 35-65; col. 9, lines 19-21, 25-36);

extracting keywords from the question (col. 5, lines 35-65; col. 9, lines 39-41);

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matching the keywords from the question and the keywords provided by the experts to generate a list of one or more experts to receive the question (col. 5, lines 35-65; col. 9, lines 39-41);

receiving responses from experts on the list of experts wanting to answer the question (col. 9, lines 25-49);

informing the customer sending the question of the experts wanting to answer the question (col. 9, lines 25-49);

establishing a connection between the customer sending the question and an expert selected by the customer from the experts wanting to answer the question, the connection comprising a telephone call to the selected expert bridged to a telephone call to the customer (col. 9, lines 5-21); and

ending the communication session when the connection is disconnected (col. 9, lines 46-50).

Regarding claims 24, 26, and 28, Lauffer does not expressly teach starting a communication session by receiving a question as a short messaging service message from one of the customers and sending the question as another short messaging service message to the experts on the list of experts (claim 24), wherein the question is submitted by short messaging service (claim 26), and wherein the expert responds to the question with a short messaging service message accepting responsibility for answering the question (claim 28). However, Lauffer discloses that communications between customers and experts “can include any method of technology used to bring

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together the consumer with one or more experts, including but not limited to telephone, Internet telephony, email, audio, and/or video. More preferably, the connection involves telephone, Internet telephony, audio, and/or video, and even more preferably Internet telephony, audio and/or video, and even more preferably video. The technology to be used for any of the above includes TVs, TVs with set-top web browsers, PCs, telephones, and satellite connections.” (Col. 9, lines 5-14) Furthermore, Official Notice is taken that the use of short messaging service messages to conduct communications was old and well-known in the art at the time of Applicant’s invention. Different people have preferences for different types of communication media; therefore, an increased availability of multiple communication media would also increase the number of people with whom communications may be established. Consequently, since Lauffer specifically states that communications between customers and experts “can include any method of technology used to bring together the consumer with one or more experts, including but not limited to...”, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant’s invention to modify Lauffer to start a communication session by receiving a question as a short messaging service message from one of the customers and send the question as another short messaging service message to the experts on the list of experts (claim 24), wherein the question is submitted by short messaging service (claim 26), and wherein the expert responds to the question with a short messaging service message accepting responsibility for answering the question (claim 28) in order to accommodate a greater number of communication media, thereby attracting a wider body of potential customers

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and experts (which in turn would potentially generate greater profit opportunities for the implementation of Lauffer's invention). Additionally, the use of short messaging service messages to communicate among users provides the convenience of instant messaging capabilities in a wireless environment.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kraft et al. (U.S. Patent No. 6,938,068) -- Discloses a system for managing an exchange of questions and answers through an expert answer web site.

Deh-Lee (US 2003/0140037) -- Discloses a dynamic knowledge expert retrieval system.

"Speech by Bundesbank Director Edgar Meister on Electronic Cash" given on November 28, 1996 in Frankfurt. Retrieved from [URL:<http://www.kuner.com/data/pay/meister.htm>] on October 10, 2006 -- Discloses various aspects of cyber money.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 8 am - 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Susanna M. Diaz
Primary Examiner
Art Unit 3623

October 11, 2006